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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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DIGEO, INC.
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EXAMINER

BUI, KIEU OANH T

ART UNIT PAPER NUMBER

2611

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/834,044 | Applicant(s) TOMSEN, MAI-IAN | |
| | Examiner KIEU-OANH T BUI | Art Unit 2611 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1&2</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.
The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).*

2. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kay et al. (U.S. Patent No. 6,711,552 B1).

Regarding claim 1, Kay discloses “a method, comprising: providing a broadcast segment as part of an interactive television transmission via a first screen; responsive to a first command received from a user input device, storing information associated with a transaction related to the broadcast segment that is capable of being conducted via a second screen; and responsive to a second command received from the user input device and subsequent to providing at least a portion of the broadcast segment, retrieving the stored information associated with the transaction and providing content related to the broadcast segment”, i.e., Kay discloses a commerce control network system and method for obtaining product information and purchasing products through a two way interactive television system, and the user has an option to save or store his/her portion of broadcast segments to his/her favorite files or “a shopping cart” for retrieving and use at a later time (see Figs., 1-3, 5b, 5c, 5d, and col. 1/lines 23-63; col. 2/lines 30-64; col. 3/lines 4-11; col. 7/line 57-col. 8/line 25 for user inputs in selecting the products on the

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screen; and col. 10/lines 47-62 for delaying the buying of products to a second screen in the favorite list, while Figure 5b illustrates a first screen for browsing and selecting to buy products from vendors).

As for claim 2, in view of claim 1, Kay discloses “wherein the first and second screens comprise screens that are capable of being presented by a television set” (Fig. 1, and col. 2/lines 30-63 for a television system is used for this commerce control system).

As for claim 3, in view of claim 1, Kay shows “wherein the first and second screens comprise screens that are capable of being presented by a computer”, i.e., screens for displaying can also be computers using window operating systems (col. 4/lines 15-26 & col. 8/lines 42-52).

As for claim 4, in view of claim 1, Kay further discloses “wherein providing the content related to the broadcast segment in response to the second command includes presenting at least some of the content via the second screen” (Figs. 6c & 6d shows screens with tabs for more than one screens for active screen, inactive screen and favorite screens with some of the contents, see col. 9/line 30 to col. 10/line 62 for details on tabs and multiple screens).

As for claim 5, in view of claim 1, Kay teaches “wherein at least some of the information associated with the transaction is capable of being entered via the user input device in cooperation with the second screen”, i.e., favorite tab screen containing favorite lists can be retrieved later and use at a delay time (col. 10/lines 47-62).

Regarding claim 6, Kay discloses “an article of manufacture, comprising: a machine-readable medium having instructions stored thereon to: receive a broadcast segment as part of an interactive television transmission and present the broadcast segment via a first screen; responsive to a first command received from a user input device, store information associated

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with a transaction related to the broadcast segment that is capable of being conducted via a second screen; and responsive to a second command received from the user input device and subsequent to providing at least a portion of the broadcast segment, retrieve the stored information associated with the transaction and provide content related to the broadcast segment”, i.e., Kay discloses a commerce control network system as a machine readable medium having instructions stored thereon and its corresponding method for receiving and obtaining product information and purchasing products through a two way interactive television system, and the user has an option to save or store his/her portion of broadcast segments to his/her favorite files or “a shopping cart” for retrieving and use at a later time (see Figs. 1-3, 5b, 5c, 5d, and col. 1/lines 23-63; col. 2/lines 30-64; col. 3/lines 4-11; col. 7/line 57-col. 8/line 25 for user inputs in selecting the products on the screen; and col. 10/lines 47-62 for delaying the buying of products to a second screen in the favorite list, while Figure 5b illustrates a first screen for browsing and selecting to buy products from vendors).

As for claims 7-10, these claims with same limitations as shown earlier are rejected for the reasons given in the scope of claims 2-6 as disclosed above.

Regarding claim 11, Kay discloses “a client apparatus for an interactive television, the client apparatus comprising: a communication interface to receive supplemental information as part of a broadcast segment in an interactive television transmission and to present the broadcast segment and supplemental information via a first screen; a processor responsive to a first command received via the communication interface from a user input device to trigger storage of data associated with a transaction related to the broadcast segment that is capable of being conducted via a second screen; and a storage unit to store the data associated with the transaction

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related to the broadcast segment and to store at least a portion of the supplemental information in response to the first command, the processor being responsive to a second command, received via the communication interface from the user input device and subsequent to display of at least a portion of the broadcast segment, to retrieve the stored data and some of the supplemental information from the storage unit and to provide the retrieved data and supplemental information for viewing by an end user”, i.e., client applications on their set top box operating system including processor, STB remote control key, STB resident applications, electronic program guide and memory therein allow the user to access and has a communication interface for operating and control the commerce control system in a two-way interaction manner (see Figs. 5a-5d & 6a-6f, and col. 7/line 25 to col. 8/line 52; and see further on claims 1 and 6 above for other limitations).

As for claims 12-15, these claims with same limitations as shown earlier are rejected for the reasons given in the scope of claims 2-6 as disclosed above.

Regarding claims 16-20, these claims for “a system, comprising: a television network connectable to a communication network to provide a broadcast segment, having supplemental information, as part of an interactive television transmission via a first screen; and a client terminal coupleable to the television network, the client terminal including: a communication interface to receive the supplemental information as part of the broadcast segment; a processor responsive a first command received via the communication inte/ace from a user input device to trigger storage of data associated with a transaction related to the broadcast segment that is capable of being conducted via a second screen; and a storage unit to store the data associated with the transaction related to the broadcast segment and to store at least a portion of the

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supplemental information in response to the first command, the processor being responsive to a second command, received via the communication interface from the user input device and subsequent to display of at least a portion of the broadcast segment, to retrieve the stored data and some of the supplemental information from the storage unit and to provide the retrieved data and supplemental information for viewing by an end user” with same limitations as shown earlier are rejected for the reasons given in the scope of claims 1-6 as disclosed above.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reichardt et al. (US 2002/0124255 A1) disclose systems and methods for coordinating interactive and passive advertisement and merchandising opportunities.

4. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (703) 305-0095. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:30 PM, with alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant, can be reached on (703) 305-4755.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Krista Bui
Art Unit 2611
September 24, 2004

A handwritten signature in black ink, appearing to read 'K. Bui', with a long horizontal line extending to the right.

**KRISTA BUI
PATENT EXAMINER**